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08/894,156	08/15/1997	BERND BRUCHMANN	524-2769-0	8696

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EXAMINER

SERGEANT, RABON A

ART UNIT PAPER NUMBER

1711

DATE MAILED: 05/19/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 051604

Application Number: 08/894,156
Filing Date: August 15, 1997
Appellant(s): BRUCHMANN ET AL.

MAILED

MAY 19 2004

GROUP 1700

Harris Pitlick
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 5, 2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 10, 11, 13, 16, and 17 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

A substantially correct copy of appealed claim 2 appears on page 16 of the Appendix to the appellant's brief. The minor errors are as follows: Within line 2 of claim 2, "isocyanate" should be "diisocyanate".

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(9) Prior Art of Record

4,152,350	Mohring et al.	May, 1979
4,192,936	Mohring et al.	March, 1980
3,903,127	Wagner et al.	September, 1975
3,976,622	Wagner et al.	August, 1976
3,367,956	Hennig et al.	February, 1968

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8-11, and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mohring et al. ('350 or '936) in view of Wagner et al. ('127 or '622) and Hennig et al. ('956).

Mohring et al. disclose the production of biuret containing polyisocyanates having a low unreacted polyisocyanate monomer content and light color, wherein diisocyanates are reacted with an alcohol component, including tertiary alcohols; an amine component; and water. See column 3, lines 10+ and columns 4-7.

While Mohring et al. disclose the use of amines, patentees fail to disclose the use of applicants' claimed nitrogen containing stabilizer. However, applicants' claimed stabilizers were

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known at the time of invention to be useful agents for the production of biurets. See column 6, lines 8+; column 9, lines 9+; and column 11, lines 35-59, within Wagner et al. See column 1, lines 53+ and column 2 (especially column 2, lines 41-63) within Hennig et al. Furthermore, Hennig et al. disclose that their biurets, derived from urea derivatives, are light in color. See examples. Additionally, it is noted that Wagner et al. disclose both amines and urea derivatives as being suitable agents for the production of biurets.

Therefore, one of ordinary skill in the art would have been motivated to utilize the nitrogen containing biuretizing agents of the secondary references in place of the amine component of Mohring et al., because one would have reasonably expected the nitrogen compounds of the primary reference and secondary references to function as equivalents, in view of the teachings within the secondary references. It has been held that it is *prima facie* obvious to substitute an equivalent component for another, where equivalency is known within the art. *In re Ruff*, 118 USPQ 343 (CCPA 1958). Furthermore, it has been held that it is *prima facie* obvious to combine components, known to be useful for the same purpose, to yield a third component to be used for the very same purpose. *In re Kerkhoven*, 205 USPQ 1069. Therefore, the position is further taken that it would have been obvious to combine known biuretizing agents, such as tert-butanol and urea, to yield a biuretizing composition suitable for producing a biuret.

Furthermore, with respect to claims 16 and 17, the position is taken that it would have been obvious to substitute the claimed species, carboxamide of formula II or acetamide, for the formamide species set forth within column 9 of Wagner et al. It has been held that when

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chemical compounds have "very close" structural similarities and similar utilities, a *prima facie* case of obviousness may be made. *In re Grabiak*, (CAFC 1985) 769 F2d 729, 226 USPQ 870.

With respect to appellants' arguments concerning the claimed amounts of the stabilizer versus the amounts disclosed within Wagner et al., it is noted that this issue was discussed by the Board of Appeals; the Board Of Appeals agreed with the examiner's rationale that the amounts used within the respective processes are comparable. Despite appellants' arguments, appellants have failed to establish that the "about 40:1" (about 2.5 mole percent) quantity of Wagner et al. is not comparable to the amount claimed by appellants. Contrary to appellants' assertions, it is clear that the currently claimed quantity range of stabilizer has been considered by both the examiner and the Board of Appeals. Additionally, the position is taken that it is immaterial with respect to what names (i.e.; biuretizing agents, stabilizers, or catalysts) are used to describe the components. The fact remains that equivalent compounds are being used in comparable amounts, within the processes. Furthermore, the examiner has considered the comparative results; however, the position is taken that applicants have failed to establish that the claimed quantity range yields an unexpected result.

Appellants have argued that none of the prior art discloses or suggests the stabilizers of claims 10, 11, 13, 16, or 17. In response, urea and ammonia are disclosed at column 11, lines 35-59 of the Wagner et al. references, ethyleneurea is encompassed by the compounds of Hennig et al. at column 2, lines 41-63, and as aforementioned, analogous amide compounds are disclosed within column 9 of Wagner et al.

The examiner has considered appellants' discussion of the data set forth within the tables; however, the position is taken that it has not been established that the showings rise to the level

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of being unexpected. As aforementioned, Hennig et al. disclose that their biurets, derived from urea derivatives, are light in color; therefore, one would expect the argued color numbers. Furthermore, appellants have not established that quantitative increases in properties proportional to increases in the amount of component utilized is indicative of an unexpected result. Lastly, it is not seen that comparative examples that lack a stabilizer, such as Comparative Example 12, are representative of the prior art, since the prior art relies upon such a component.

(11) Response to Argument

Appellants' arguments have been addressed within the *Grounds of Rejection*.

For the above reasons, it is believed that the rejections should be sustained.

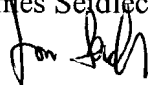
Respectfully submitted,


RABON SERGENT
PRIMARY EXAMINER

R. Sargent
May 17, 2004

Conferees:

Supervisory Patent Examiner James Seidleck





Supervisory Patent Examiner David Wu

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